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Ludovic Poupinet

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25944 7590 12/03/2008

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EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1794

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12/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 11/21/2008 has been entered. Currently claims 12-16 and 20-22 are pending and claims 1-11 and 17-19 are cancelled.

### ***Response to Arguments***

2. Applicant's arguments, see Remarks, filed 11/21/2008, with respect to the objection to claims 16 and 19 and the rejection of claim 13 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The relevant objection and rejection have been withdrawn.

3. Applicant's arguments filed 11/21/2008 have been fully considered but they are not persuasive.

Claims 12-14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (4,405,706), claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (4,405,706), as applied to claim 12, in view of either Stevens (6,177,168) or Holster et al. (4,450,553), claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (4,405,706), as applied to claim 20, in view of Tamura et al. (5,354,590) for the reasons mentioned in the previous Office Action (07/22/2008) and for the reasons mentioned below.

Applicants first argue that it would not have been obvious to one having ordinary skill in the art to make a bimetallic Zn-Te alloy from the list of preferred metals disclosed in Takahashi et al.

The Examiner respectfully disagrees and notes that applicants cite the very passage where Takahashi et al. disclose a Zn-Te alloy (Remarks page 6, second paragraph). Takahashi et al. disclose at col. 3, lines 52-58 a list of metals for a heat mode recording layer, and further qualify a subset of preferred metals. In this same section they state that these metals may be "used individually or in combination." The use of the term in combination clearly denotes that metals may be combined in an alloy. A bimetallic alloy is the simplest form of a "combination" of metals, and given the fact that Takahashi et al. do not **specifically** exclude bimetallic alloys; the Examiner deems that Takahashi et al. discloses bimetallic alloys.

Having established this, the Examiner now turns his attention to selection of zinc and tellurium in said bimetallic alloy. It has been held that "[w]hen the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the

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compounds included in the generic formula before any of the compounds can be "at once envisaged." One may look to the preferred embodiments to determine which compounds can be anticipated. In re Petering, 301 F.2d 676, 133 USPQ 275 (CCPA 1962)." Please see MPEP 2131.02. Given the fact that Takahashi et al. disclose a list of **preferred** metals, and also given the fact that Takahashi et al. disclose that these metals may be "used individually or in combination," it is **clearly envisaged** by the Examiner to form the bimetallic Zn-Te alloy. This is not an obvious to try argument, nor is this usage of improper hindsight rationale as suggested by applicants.

With specific regard to applicants' assertion that the use of an "obvious to try" argument would be inappropriate to support this rejection, the Examiner notes that applicants define this rationale as "finding that there was a finite number of identified, predictable potential solutions to a recognized need or problem." They then go on to calculate that there would be approximately 100 possible combinations of metals from the preferred metals listing (in actuality it would be 127 combinations total, i.e.  ${}^7C_1 + {}^7C_2 + {}^7C_3 + {}^7C_4 + {}^7C_5 + {}^7C_6 + {}^7C_7$ ), and finally they state that "[t]hus, it is not possible to find that there was a finite number of identified, predictable potential solution to a recognized need or problem." This line of argument is unclear as applicants have clearly provided a finite number of possibilities, and the Examiner has demonstrated that one of ordinary skill can quickly identify the total number of possibilities, thereby making it finite.

Applicants also argue that it would not have been obvious to one having ordinary skill to optimize the relative percentages of zinc and tellurium in a bimetallic alloy.

The Examiner disagrees and notes that the basis for optimization is a result-effective variable based upon what is known in the prior art at the time of the invention. The Examiner provided a basis for optimizing these result-effective variables in the Office action mailed on 07/22/2008; specifically, promoting sensitivity and largest signal-to-noise. These result-effective variables would have been known to one having ordinary skill in the art of optical disc manufacture at the time the present invention was made, and they also would have been known at the time the invention of Takahashi et al. was made. Also it has been held that “[g]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” Please see MPEP 2144.05 and *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). The Examiner maintains his rejection that it would have been obvious to one having ordinary skill in the art to optimize the percentage of metals in a bimetallic alloy.

4. With regard to the provisional rejection of claims 12-16 and 20-22 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 12-22 of copending Application No. 10/535,411, the Examiner notes that “[i]f a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that

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rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.” Please see MPEP 804; however, since there remain other grounds for rejection in this case, the Examiner maintains his provisional ODP rejection.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Gerard T Higgins  
Examiner  
Art Unit 1794

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